



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT
APPEALS AND INTERFERENCES

In Re Application of:)
)
Tami L. Guy;)
Jeffrey L. Briggs and)
Anne L. Mason)
) Group Art Unit: 3627
)
Serial No. 09/965,405)
) Examiner: Richard E. Chilcot
)
Filed: September 26, 2001)
)
For: METHOD OF) Atty Dkt. 10013329-1
DISTRIBUTING)

REPLY BRIEF

MAIL STOP APPEAL BRIEF - PATENTS
COMMISSIONER FOR PATENTS
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450

RECEIVED
OCT 04 2004
GROUP 3600

Dear Sir:

This Reply Brief is submitted in response to the Examiner's Answer mailed July 29, 2004, as permitted by 37 CFR §1.193(b)(1).

The comments contained herein are intended to be supplemental to those presented in appellants' Appeal Brief filed May 7, 2004. It is noted that appellants, in this Reply Brief, respond only to certain issues raised in the Examiner's Answer where response is deemed warranted. With respect to the

Serial No. 09/965,405
Art Unit 3627
Atty Dkt. 10013329-1

remaining issues contained in the Examiner's Answer, appellants' position is fully set forth in the Appeal Brief filed on May 7, 2004, and appellants make no admissions or concessions herein regarding these remaining issues.

The Examiner states the following on page 4 of the Examiner's Answer, with respect to the rejection of claim 1:

Turning now to Webber, Jr., we see a system that has a first organization (an ISP, private provider, web page, etc.) which has entered into a contractual agreement with a second organization (broker, marketer) to take orders for a third organization (winery). It is clear the orders taken by the second organization are for products and services not provided by the first organization.

As discussed in appellants' Appeal Brief (e.g., pages 17-18), the Examiner, in the final Office action mailed December 15, 2003, relies upon "Example 1" in Webber, Jr. (col. 12, lines 42-52) to support the rejection of appellants' claim 1. In the Appeal Brief, appellants responded to this rejection and explained why Example 1 of Webber, Jr. does not teach or suggest the limitations of claim 1.

The Examiner now appears to be relying on a different portion of the Webber, Jr. reference, although it is not clear to appellants what portion this is. It is believed, however, that the Examiner *may be* referring generally to col. 6, lines 13-27 of the reference (reproduced below) since this is the only place where Webber, Jr. mentions the specific term "ISP" as used by the Examiner.

The **system** provides the computational mechanism, **physically independent of the parties**, wherein the

business of the trading partners of the supply chain is conducted, as opposed to conducting the computing physically at the facilities of each and every party to the supply chain. **The system may operate advantageously as a private or an Internet Service Provider (ISP).** The computers of the parties are connected by modem to the communications and activity platform ("CAP") or by other means. The system provides a module that defines the means and terms for each parties' digital connection of their computer(s) with the system.

The system advantageously provides a template or toolkit that helps the parties draft or program their own contracts. When authorized by the parties to the programmed contract, the contract is stored for future use.

(Webber, Jr., col. 6, lines 13-27, emphasis added)

This portion of the Webber, Jr. reference clearly does not support the instant rejection of appellants' claim 1. In the above passage, the "ISP" (or private provider) is the *system itself* and not one of the parties to the transaction as suggested by the Examiner. It is noted that Webber, Jr. describes the "system" as that which "provides the computational mechanism, **physically independent of the parties**". *Id.* (emphasis added).

On page 4 of the Examiner's Answer, the Examiner states the following:

With respect to Appellants' argument that Webber, Jr. taken alone or in combination suggests [sic - does not suggest] the features of claims 2-5 of the instant application,

the examiner presents to [sic] following findings. Firstly, appellants have not cited the particular features not taught by Webber, Jr. Secondly, Webber, Jr. discloses numerous organizations that provide services and/or products to customers; for example, financial institutions and shippers.

With respect to the Examiner's first point, the Examiner indicates that appellants have failed to cite particular claim features not taught by Webber, Jr. In response, appellants assert that, in the present case, it is not necessary to point out specific claim features because the Examiner *admits*, in the final Office action, that the limitations of claims 2-5 are not met by Webber, Jr. This is discussed in appellants' Appeal Brief, for example, on page 22. Since the Examiner *admits* that all of the limitations of appellants' claims are not met by the reference, there would seem to be little point in further addressing this issue. It is noted that, although admitting that appellants' claim limitations are not met, the Examiner takes the position, nevertheless, that the claims are unpatentable (i.e., obvious) over Webber, Jr. Because, however, the Examiner does not provide any *evidence* supporting this position, the Examiner has failed to establish a *prima facie* case of obviousness. This is also discussed on page 22 of appellants' Appeal Brief.

With respect to the Examiner's second point, appellants respectfully assert that it is irrelevant whether or not Webber, Jr. "discloses numerous organizations that provide services and/or products to customers ..." as argued by the Examiner; the proper

issue is whether or not Webber, Jr. discloses the subject matter encompassed by the specific limitations of appellants' claims. As discussed above (and as discussed in appellants' Appeal Brief), the Examiner has failed to establish this condition.

The Examiner states the following on page 4 of the Examiner's Answer:

Concerning appellants' argument that Webber, Jr. does not teach the features of claims 6 and 7, the examiner respectfully disagrees. As seen in col. 7, lines 49-60, of Webber, Jr., there is a digital record which confirms the item(s) was delivered.

In the final Office action, the Examiner took the position that the rejection of claims 6 and 7 was supported by the language of Webber, Jr. as set forth at "col. 11, lines 1+" of the reference. (final Office action, page 2). This position is discussed and disputed on pages 23-24 of appellants' Appeal Brief.

In the Examiner's Answer, however, the Examiner apparently changes the position advanced in the final Office action, and now points instead to col. 7, lines 49-60 of Webber, Jr. Although this newly-specified portion of the reference does generally discuss confirming that an item was delivered, it does not discuss verifying that a *service* was performed (claim 7). This portion of Webber, Jr. also does not disclose "verifying that said *third organization* product was received" (claim 6, emphasis

added) or "verifying that said *third organization* service was performed" (claim 7, emphasis added).

The Examiner states the following on page 5 of the Examiner's Answer:

Concerning appellants' argument that Webber, Jr. does not teach "requiring the third organization to notify the first organization when the order exceeds a predetermined credit limit of the second organization", as found in claim 18, the examiner is of another opinion. As seen in col. 12, lines 5-11 of Webber, Jr. the transfer of funds is delayed until a flag is removed. It has been notoriously well known that financial flags as set for exceeding predetermined credit limits. [sic]

With respect to the last sentence reproduced above, it is not clear what the Examiner is asserting "has been notoriously well known". It is clear, however, that the Examiner is asserting that something is "notoriously well known" rather than supplying *evidence* in support of the rejection. It is well established that it is improper for an examiner to substitute his or her personal opinion for evidence when rejecting a claim:

Whether the Board relies on an express or an implicit showing [of a motivation, suggestion or teaching to modify the teachings of a reference], it must provide particular findings related thereto.... Broad conclusory statements standing alone are not "evidence".

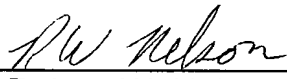
Serial No. 09/965,405
Art Unit 3627
Atty Dkt. 10013329-1

In re Kotzab, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000) (citing
In re Dembiczak, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999))

Accordingly, appellants again respectfully assert that the
Examiner has failed to establish a *prima facie* case of
obviousness.

Respectfully submitted,

KLAAS, LAW, O'MEARA & MALKIN, P.C.

By 
Robert W. Nelson
Registration No. 37,898
1999 Broadway, STE 2225
Denver, CO 80202
(303) 298-9888

09-30-04

AF/ 3627 123
PATENT APPLICATION
ATTORNEY DOCKET NO. 10013329-1



IN THE
UNITED STATES PATENT AND TRADEMARK OFFICE

Inventor(s): Tami L. Guy et al.

Confirmation No.: 3798

Application No.: 09/965,405

Examiner: Richard Chilcot

Filing Date: Sept. 26, 2001

Group Art Unit: 3627

Title: METHOD OF DISTRIBUTING

Mail Stop Appeal Brief-Patents
Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

TRANSMITTAL OF REPLY BRIEF

Sir:

Transmitted herewith in **triplicate** is the Reply Brief with respect to the Examiner's Answer mailed on July 29, 2004. This Reply Brief is being filed pursuant to 37 CFR 1.193(b) within two months of the date of the Examiner's Answer.

(Note: Extensions of time are not allowed under 37 CFR 1.136(a))

(Note: Failure to file a Reply Brief will result in dismissal of the Appeal as to the claims made subject to an expressly stated new grounds of rejection.)

No fee is required for filing of this Reply Brief.

If any fees are required please charge Deposit Account 08-2025.

RECEIVED
OCT 04 2004
GROUP 3600

(X) Express Mail Label No. EL969918551US

I hereby certify that this correspondence is being deposited with the United States Postal Service as express mail in an envelope addressed to:
Commissioner for Patents, Alexandria, VA
22313-1450. Date of Deposit: 9/28/04

OR

() I hereby certify that this paper is being transmitted to the Patent and Trademark Office facsimile number _____ on _____

Number of pages: 9

Typed Name: Angela Trousse

Signature: Angela Trousse

Respectfully submitted,

Tami L. Guy et al.

By RW Nelson

Robert W. Nelson, Esq.

Attorney/Agent for Applicant(s)

Reg. No. 37,898

Date: 9-28-04

Telephone No.: (303) 298-9888